

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 068351.0141	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EV352440655US Mail Stop AF, Commissioner for Patents Office, P.O. Box 1450, Alexandria, VA 22313-1450.</p> <p>on <u>12/29/06</u></p> <p>Signature <u></u></p> <p>Typed or printed name <u>Alfonso Javer</u></p>		Application Number 10/626,006	Filed 07/24/2003
		First Named Inventor Mark B. Lyles	
		Art Unit 1731	Examiner Dionne Walls Mayes
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,790</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

Signature
Bruce W. Slayden II
Typed or printed name
512.322.2606
Telephone number
12/21/2006
Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

ATTORNEY DOCKET
068351.0141

PATENT APPLICATION
10/626,006

1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Mark B. Lyles
Serial No.:	10/626,006
Date Filed:	July 24, 2003
Group Art Unit:	1731
Examiner:	Mayes, Dionne Walls
Title:	NUCLEIC ACID BASED FILTERS

MAIL STOP – AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Rejections under 35 U.S.C. §103

Claims 1-5, 10-14, and 58-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,097,846 issued to Clauss Burkart Strauch ("Strauch") and in view of U.S. Patent No. 6,613,753 issued to Joseph Rubinfeld *et al.* ("Rubinfeld"). Applicant respectfully traversed and submitted the cited art combination, even if proper, which Applicant did not concede, did not render the claimed embodiment of the invention obvious.

Applicant previously reminded the Examiner that in order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Applicant has pointed out that all pending claims are directed to filters which include the nucleic acid apurinic acid. Apurinic acid is a nucleic acid. The filters of the invention are useful for removal of carcinogens from, *e.g.*, cigarette smoke. (*See* page 6, lines 1-8)

Strauch cited by the Examiner relates to "Nasal Inhalers" for application of medications, *e.g.*, Strauch teaches his nasal inhaler is "provided with an absorbent filter adapted to filter air or smoke and preferably carry at the same time medications through the inhaled air." (Col. 1, lines 1-9) Strauch does not teach or suggest the removal of carcinogens from cigarette smoke but the opposite -- Strauch's invention is directed to allowing carcinogens to pass into the lungs of a user

and at the same time also carrying along with the carcinogens some type of medication for treatment. While no specific medications are disclosed; however, it is clear that Strauch in no way teaches the filtering out of carcinogens or the filtering out of carcinogens using the nucleic acid apurinic acid, *e.g.*, prior to the smoke reaching the lungs of a smoker.

Rubinfeld *et al.* cited by the Examiner is directed to "Restore Cancer-Suppressing Functions to Neoplastic Cells through DNA Hypomethylation." Basically, Rubinfeld is directed to a method of treating cancer, not preventing it and certainly not preventing it by filtering carcinogens out of, *e.g.*, cigarette smoke or using apurinic acid to do so. For example, Rubinfeld *et al.* teach: "The method comprises: delivering to a patient suffering from cancer a therapeutically effective amount of a DNA methylation inhibitor" (Abstract) The pending claims are not directed to treating cancer or delivering a therapeutic amount of any agent to a user. Just the opposite, the present invention is directed to the blocking or inhibition of the delivery of cancer causing agents, *i.e.*, carcinogens. For example, carcinogens are filtered out of the smoke by the apurinic acid contained in the filter. And it is unclear why the Examiner considers apurinic acid, a nucleic acid, as an anti-neoplastic or anti-cancer agent as disclosed in Rubinfeld *et al.* Apurinic acid is certainly not mentioned in Rubinfeld *et al.* as such and Rubinfeld *et al.* is directed to anti-neoplastic or anti-cancer agents that are effective in treating abnormal cell proliferation such as cancer. The present inventive claims are directed to the non-delivery or removal of carcinogens before they enter a human, not the treatment of carcinogens in the human body.

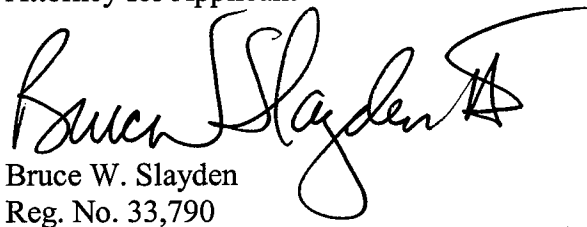
The combination of Strauch and Rubinfeld *et al.* does not, even if proper, yield the claimed invention. The combination of Strauch with Rubinfeld *et al.* would, at best, teach the nasal delivery of anti-neoplastic agents of Rubinfeld *et al.* with Strauch's nasal inhaler. Neither Strauch nor Rubinfeld *et al.* teach the inhibition or blocking, *e.g.*, filtering out, of carcinogens using any means and certainly do not teach or suggest, alone or in combination, the use of the nucleic acid, apurinic acid, to reduce or remove carcinogens from a source, *e.g.*, cigarette smoke. Applicant submits all claims are allowable over the cited art.

CONCLUSION

Applicant submits this Pre-Appeal Brief Request for Review, along with a Notice of Appeal, and authorize the Commissioner to charge \$250.00 to cover the filing fee for the Notice of Appeal to Deposit Account No. 50-2148 of Baker Botts L.L.P..

If there are any matters concerning this request that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2606.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicant


Bruce W. Slayden
Reg. No. 33,790

Date: 12/21/2006

SEND CORRESPONDENCE TO:
BAKER BOTTS L.L.P.
CUSTOMER ACCOUNT NO. **31625**
512.322.2606
512.322.8383 (fax)